

## *REMARKS*

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 1-17 are now present in this application. Claims 1, 6, 8, 9, 12 and 13 are independent. Claims 2, 3, 6-12 and 15 are amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

### *Priority Under 35 U.S.C. § 119*

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

### *Drawings*

Applicants acknowledge with appreciation the statement in the Form PTO-326 that the formal drawings filed on November 19, 2003 are accepted.

Rejection Under 35 U.S.C. § 102

Claim 1-5, 7-11 and 13-17 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,480,687 to Heming et al. ("Heming"). This rejection is respectfully traversed.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). This burden can be satisfied when the PTO presents evidence, by means of some teaching, suggestion or inference either in the applied prior art or generally available knowledge, that would have appeared to have suggested the claimed subject matter to a person of ordinary skill in the art or would have motivated a person of ordinary skill in the art to combine the applied references in the proposed manner to arrive at the claimed invention. See Carella v. Starlight Archery Pro Line Co., 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); In re Rinehart, 531 F.2d 1048, 1051-1052, 189 USPQ 143, 147 (CCPA 1976).

If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting

patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the examiner, inherence may not be established by probabilities or possibilities. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

In this regard, Applicants respectfully note that there can be no speculation or only possibilities involved in a holding of inherency. What is alleged to be inherent must necessarily occur. The mere fact that something *may* result from a given set of circumstances is not sufficient. In re Oelrich, 212 USPQ 323, 326 (CCPA 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

With respect to claim 1, Applicants respectfully submit that they can find no disclosure, either explicit or inherent, in Heming the combination of features positively recited in claim 1, including irradiating an ultraviolet ray to the core layer to pre-cure a surface of the core layer. Heming merely discloses that the film applied from the liquid phase is first dried and that condition can be shaped by the impression of a die (col. 12, lines 12-22). Applicants have not found a disclosure of pre-curing a core layer using an ultraviolet ray. Nor does the Office Action point out what specific language in Heming allegedly discloses this claimed feature.

Similarly, with respect to claim 8, Heming does not disclose, explicitly or inherently, a method for fabricating a polymeric optic waveguide using a master that is pre-cured with a predetermined light.

Further, with respect to claims 2, 8 and 14, Applicants have not found where, in Heming, side bar regions for screening, as recited, are explicitly or inherently found. Nor does the Office Action point out what specific language in Heming allegedly discloses this claimed feature.

Further, with respect to claims 3, 9 and 15, Applicants have not found where, in Heming, side bar regions, as recited, are explicitly or inherently found, or where a rib-type optical grating is formed, as recited. Nor does the Office Action point out what specific language in Heming allegedly discloses these claimed features.

Further, with respect to claim 13, Applicants respectfully submit that they can find no disclosure, either explicit or inherent, in Heming the combination of features positively recited in claim 13, a polymeric optical device including a grating which is made by a method including irradiating an ultraviolet ray to the core layer to pre-cure a surface of the core layer. Heming merely discloses that the film applied from the liquid phase is first dried and in that condition can be shaped by the impression of a die (col. 12, lines 12-22). Applicants have not found a disclosure of a polymeric optical device including a grating which is made by pre-curing a core layer using an ultraviolet ray. Nor does the Office Action point out what specific language in Heming allegedly discloses this claimed feature.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of the claimed invention recited in claims 1-5, 7-11 and 13-17 by Heming.

Applicants respectfully submit that Heming does not disclose the claimed invention explicitly or inherently for the reasons stated above.

Reconsideration and withdrawal of this rejection under 35 U.S.C. §102(b) of claims 1-5, 7-11 and 13-17 are respectfully requested.

Allowable Subject Matter

The Examiner states that claims 6 and 12 would be allowable if rewritten in independent form.

Applicants thank the Examiner for the early indication of allowable subject matter in this application. Objected-to claims 6 and 12 have been rewritten into independent form, and should therefore be allowed.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Application No.: 10/715,469  
Art Unit 2883

Attorney Docket No. 3449-0286P  
Reply to July 14, 2005 Office Action  
Page 13

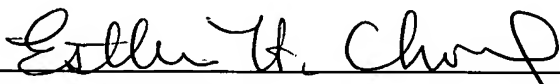
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:   
Esther H. Chong  
Reg. No.: 40,953

*EHC/RJW:gf*

P.O. Box 747  
Falls Church, Virginia 22040-0747  
Telephone: (703)205-8000